



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,010	08/25/2000	Nobuyuki Tomihashi	20-4744P	5697

2292 7590 03/13/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
----------	--------------

1713

14

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/623,010	Applicant(s) TOMIHASHI ET AL.	
	Examiner D. R. Wilson	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/03 has been entered.
2. Applicant's election of the Group V inventions, now Claims 10 and 12-13, in Paper No. 6 remains in effect. Additionally, election of species of the fluoroelastomer and polyol used in Example 1, in the same Paper also remains in effect, i.e., (a) a vinylidene fluoride/tetrafluoroethylene/hexafluoropropylene copolymer as the fluoroelastomer, and (b) the sodium salt of bisphenol AF as the basic polyol curing agent.

Response to Amendment

3. Applicant's amendment filed 2/19/03 (previously filed and not entered on 1/24/03), has been fully considered with the following results.
4. The amendment overcomes the rejection of Claims 10, 12 and 13 under 35 U.S.C. § 112, first paragraph, and the rejection is withdrawn.
5. The amendment is not deemed to be persuasive in overcoming the prior art rejections which are maintained for the reasons discussed below.

Previously Cited Statutes

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112, Second Paragraph

7. Claims 10 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly amended Claim 10 recites the presence of curing agents which are said to be quaternary salts of tertiary amines. However, this is then recited to be a salt of a tertiary amine and an

Art Unit: 1713

organic or inorganic acid. Quaternary salts of tertiary amines have the formula $R_4N^+ X^-$, wherein R is an organic group. Salts of tertiary amines R_3NH with acids HX have the formula $R_3NH^+ X^-$. Thus, it become unclear what applicant is trying to claim.

Claim Rejections - 35 USC § 102/§ 103

8. ***Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by EP'096.***

The basis of this rejection was stated in Detailed Action § 11-12 of the Office Action of 3/19/02, and was further discussed in Detailed Action § 7-9 of the previous Office Action.

9. Applicant has amended the claims to now include the presence of a quaternary salt as a curing accelerator. As noted by applicant, EP'096 teaches the optional inclusion of a curing accelerator at page 14, lines 15-18, which specifically includes a quaternary ammonium salt. It is also noted that use of a tertiary amine as an accelerator would become a salt by reaction with any liberated HF.

10. Applicant traverses the rejection arguing that the vulcanizing aid BDU-b, a quaternary ammonium salt, disclosed by EP'076 at col. 4, lines 15-17 "--- is a strong base, whereby its addition to a fluoroelastomer curable coating composition enhances the elimination of HF from the fluoroelastomer." This is interesting supposition, but not deemed to be persuasive. BDU-b is a quaternary ammonium salt as is instantly claimed, and it is not seen that is a strong base, nor has applicant provided any evidence that this vulcanization aid enhances the elimination of HF, particularly in the presence of the strongly basic bisphenol AF disodium salt. The further argument that the result of adding DBU-b is that the composition has a shorter pot life is also an interesting supposition not supported by any facts. Further, the claims under consideration are to the coated article, not to a curable coating composition. Thus, pot life is not seen to be a property of importance in what is being claimed, and it is not seen that the coated article has been shown to be different in any significant way.

11. ***Claims 10, 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over EP'096 in view of Kometani'913, Sonoi'686 or Yamamoto'902.*** The basis of this rejection was stated in Detailed Action § 14-15 of the Office Action of 3/19/02, and was further discussed in Detailed Action § 10-13 of the previous Office Action. As has previously been noted, Kometani'913, Sonoi'686 or Yamamoto'902 replace the previously used Examiner's Notice.

Art Unit: 1713

12. Applicant traverses the rejection arguing that the teachings of Kometani'913, Sonoi'686 or Yamamoto'902 are far more removed from the present invention than the EP'096 reference. This is not deemed to be persuasive because applicant is focusing solely on the teachings of these added references as opposed to the teachings relied upon in the rejection.

Applicant cannot show non-obviousness by attacking the reference individually where, as here, the rejection is based on a combination of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

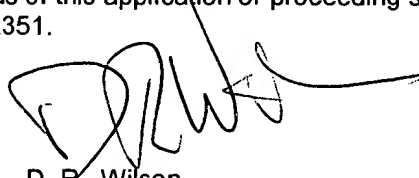
13. The added teachings of Kometani'913, Sonoi'686 or Yamamoto'902 have only been used to show what one of ordinary skill in the art would envisage or know is included in the metal salts of bisphenol AF which are taught to be used by EP'096. The Examiner has not relied on these added teachings for any disclosure of the specific fluoroelastomers, curable compositions, or articles therefrom, which are taught by EP'096.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. Wilson
Primary Examiner
Art Unit 1713